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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,996	09/19/2005	Oliver Voelckers	101185-21	7948
27387	7590	11/12/2009		
LONDA, BRUCE S. 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022			EXAMINER WALTHALL, ALLISON N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,996

Applicant(s)

VOELCKERS, OLIVER

Examiner

ALLISON WALTHALL

Art Unit

2629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-11, 13-15, 17, 18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-11, 13-15, 17, 18, 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed August 6, 2009 has been entered. Claims 4-11, 13-15, 17, 18, and 20-28 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-11, 20, 22, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "the circular upper surface (20) and the underside (16) being parallel to one another across the entire disc-shaped control element (11)." However, as shown in Figs. 3 and 4 of applicant's drawings, the edges of the upper surface 20 and the underside 16 curve downward and upward, respectively, so that the upper surface in fact meets the underside to form an edge surface. Therefore they are not parallel to one another across the entire disc-shaped control element.

Claim 26 recites "the only indirect contact between the control element (11) and the application casing (15) is via the plural springs (17)." However as shown in applicant's Figs. 3 and 4, the sensors 18 also provide indirect contact between the control element 11 and the application casing 15.

Claims 4-11 and 22 are rejected because they depend from claim 20.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch (DE 410015) in view of Gaultier (US Patent 5,543,592).

As to **claim 20**, Bihusch teaches a control element for electronic appliances comprising a disc-shaped control element (swingplatte, figure 10) having a circular upper surface and an underside (figure 2);

an application casing (the bottom portion of figure 2);

a sensor (strain gauges) mounted against the underside (figure 2);

a plurality of springs positioned between the application casing and the underside of the disc-shaped control element (figure 2) in a ring-shaped fashion (i.e. the springs are positioned along a ring encircling the center axis) and arranged close to an edge of the disc-shaped control element (figure 2);

the disc-shaped control element, the sensor, and the plurality of springs are mounted about a common axis (the center point of figure 10);

the disc-shaped control element is tiltable about the axis by being manually manipulated any point along a circumference of the circular surface (i.e. can be tilted in any direction relative to the horizontal, see English abstract), causing the sensors to

provide a cursor movement (i.e. operate as a mouse, generate x and y coordinate signals).

Bihusch does not teach the circular upper surface and the underside being parallel to one another across the entire disc-shaped control element. Gaultier teaches a disc-shaped control element (8, figure 6) having a circular upper surface (top surface of 8) and an underside (lower surface of 9) being parallel to one another across the entire disc-shaped control element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a disc-shaped control element having an upper surface and underside being parallel to one another across the entire disc-shaped control element as taught by Gaultier for the cap-shaped control element of Bihusch, yielding predictable results of tilting the disc relative to the center axis.

As to **claim 6**, Bihusch teaches the control element exhibits a smooth surface (figure 2).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view of Kishi (US Patent 5,903,229) and Sin (US Patent 5,939,684).

As to **claim 21**, Bihusch teaches a control element for electronic appliances comprising a disc-shaped control element (swingplatte, figure 10) having a circular surface and an underside (figure 2);

an application casing (the bottom portion of figure 2);

a sensor (strain gauges) mounted against the underside and above the application casing (figure 2);

a plurality of springs arranged between the application casing and the underside of the disc-shaped control element (figure 2);

the disc-shaped control element, the sensor, and the plurality of springs are mounted about a common axis (the center point of figure 10);

Bihusch does not teach a transmission element (26) arranged on the disc-shaped control element; a rotatable actuation disc (22) arranged on the transmission element (26), the rotatable actuation disc (22) having about its perimeter a downwardly projecting border area (25); the disc-shaped control element (11) is tiltable about the axis by manually rotating the actuation disc (22) at any point along a circumference of the actuation disc (22), causing the sensors to provide a cursor movement.

Kishi (figure 24) teaches a rotatable actuation disc (21) arranged on a transmission element (i.e. rotatably attached) arranged on the disc-shaped control element (main body); manually rotating the actuation disc at any point along a circumference of the actuation disc to provide cursor movement (see column 1, line 58 column 2, line 16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the actuation disc of Kishi on the disc-shaped element of Bihusch, such that the disc-shaped control element is tilted at the point of a user's finger pressing on the actuation disc, causing the sensors of Bihusch to provide a cursor movement, in order to make it easier for the user to rotate their finger along the

circumference. Since Bihush teaches the control element having about its perimeter a downwardly projecting border area (see figure 2), it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the rotatable actuation disc of Kishi also having about its perimeter a downwardly projecting border area, in order to cover the entire control element.

However, Bihusch and Kishi do not teach the border area (25) being disposed between but without contacting the disc-shaped control element (11) and the application casing (15); Sin teaches an actuation disc 12 shaped like a cap having a rounded edge terminating in a border area projecting downwardly from the actuation disc (see figure 13), wherein the border area is disposed outside the disc shaped control element 14 without contacting the disc shaped control element and the application casing 22. Thus Bihusch figure 7 which teaches the application casing projecting upward outside the border area, when modified by Sin to include actuation disc 12, teaches the border area disposed between the control element 53 and an application casing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the actuation disc of Sin in the control element of Bihusch in order to integrate a jog shuttle and contact switch.

7. Claims 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki (JP 07-107574) in view of Bihusch.

As to **claim 25**, Miyazaki teaches a method for controlling electronic appliances, comprising the steps of providing a disc-shaped control element (7) having a surface and being tiltable around an axis (i.e. inclined, see abstract),

providing a sensor (pressure sensors 43, see drawings 10 and 11, which is axially disposed below the disc-shaped control element (i.e. internally coupled to 7),

sliding a finger (see figure 4, 5, and 19) over the disc-shaped control element to provide pressure onto an edge of the disc-shaped control element (i.e. lightly pushed down, see abstract), providing a tilt of the disc-shaped control element (i.e. inclined), and actuating a sensor located below the disc-shaped control element thereby registering the tilt (i.e. sensors detect the inclination direction, see abstract),

connecting the sensor to a micro processor (71) controlling a cursor movement (i.e. function mark or instruction mark) (see [0043] and [0046], see figures 4, 5, and 19),

continuing the sliding of the finger over the disc-shaped control element for continued cursor movement (see [0058], figures 9 and 13, see also figures 4, 5, and 19).

Miyazaki does not specifically teach providing a plurality of springs arranged axially around the sensor, and pressing down the on at least one of the plurality of springs. Bihusch teaches a plurality of springs (see figure 2) arranged axially around the axis of the control element, and pressing down on the plurality of springs (i.e. the control unit is tilted by hand pressure). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the springs of Bihusch in the

method of Miyazaki in order to return the control element to neutral position after being pressed and released.

As to **claim 28**, Bihusch teaches wherein registering the tilt comprises evaluating the sensors to determine a position of actuation of the control element. (see abstract "four strain gauges are positioned to generate plus and minus x and y coordinate signals when tilted by applied hand pressure" and result page "the direction of cursor movement is determined by the relationship of the moduli of elongation of abscissa and ordinate strain gauges.")

8. Claims 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view of Gaultier, as applied to claim 20 above, and further in view of Kishi.

As to **claim 4**, Kishi teaches the control element (main body) equipped with a rotatable actuation disc (21) (see reason above).

As to **claim 5**, Kishi teaches the actuation disc is rotatable around an axis of the control element and is pivoted and supported over transmission elements (attachments) on the surface of the control element (see column 1, line 58-column 2, line 16).

As to **claim 7**, Kishi teaches the actuation disc exhibits a structured surface (see figure 24).

As to **claim 8**, Kishi teaches the actuation disc exhibits a geometric form tuned to the control element (see figure 24).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view of Gaultier and Kishi as applied to claim 4 above, and further in view of Sin.

As to **claim 9**, Bihusch teaches a border area projecting downwardly from the actuation disc (see figure 7) inside the application casing. Sin teaches an actuation disc 12 shaped like a cap having a rounded edge terminating in a border area projecting downwardly from the actuation disc (see figure 13), wherein the border area is disposed outside the disc shaped control element 14 without contacting the disc shaped control element and the application casing 22. Thus Bihusch figure 7 which teaches the application casing projecting upward outside the border area, when modified by Sin to include actuation disc 12, teaches the border area disposed between the control element 53 and an application casing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the actuation disc of Sin in the control element of Bihusch in order to integrate a jog shuttle and contact switch.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view Gaultier and Kishi, as applied to claim 4 above, and further in view of Lee (US Patent 6,804,027).

Regarding **claim 11**, Bihusch, Gaultier, and Kishi disclose the control element according to claim 4, but do not specifically teach wherein the appliance casing exhibits tick marks next to the edge of the control element consisting of twelve marks in regular intervals where the actuation disc is arranged on the control element.

However, Lee teaches an appliance casing exhibits tick marks next to the edge of the control element consisting of eight marks in regular intervals where the actuation disc is arranged on the control element (Fig. 7, a control knob 701 with tick marks arranged on the housing around the outside of the control knob). It would have been obvious to have twelve tick marks in regular intervals depending on the user's or manufacturer's preference. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to have combined the housing with tick marks as taught by Lee with the control element of Bihusch as modified by Gaultier and Kishi for the purpose of accurate adjustments (col. 4 lines 33-40).

11. Claims 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view of Gaultier, as applied to claim 20 above, and further in view of Nuovo, US Design D490,405 S.

Regarding **claim 10**, Bihusch in view of Gaultier discloses the control element according to claim 20, but does not specially teach wherein the control element exhibits tick marks consisting of twelve marks in regular intervals.

However, Nuovo teaches in Fig. 1 a control element exhibits tick marks consisting of twelve marks in regular intervals. It would have been obvious to one of ordinary skill in the art at the time of invention was made to have added twelve tick marks in regular intervals as taught by Nuovo to the control element of Bihusch as modified by Gaultier for the purpose of providing tactile feedback for the user.

Regarding **claim 22**, Nuovo teaches the control element includes tick marks.

12. Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bihusch in view of Kishi and Sin, as applied to claim 21 above, and further in view of Nuovo.

Regarding **claim 23**, Bihusch Kishi and Sin teach the control element according to claim 21, but do not specially teach the rotatable actuation disc includes tick marks.

However, Nuovo teaches in Fig. 1 a disc exhibits tick marks. It would have been obvious to one of ordinary skill in the art at the time of invention was made to have added tick marks of Nuovo to the rotatable actuation disc of Bihusch as modified by Kishi and Sin, for the purpose of providing tactile feedback for the user, since the rotatable actuation disc is on top of the control element and is in contact with the finger.

As to **claim 24**, Kishi teaches the rotatable actuation disc includes rounded edges (i.e. the disc is round).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch as applied to claim 25 above, and further in view of Yamazaki (US Patent 5,815,139).

As to **claim 13**, Miyazaki and Bihusch teach the method of claim 25 but do not specifically teach a stronger increasing pressure during the actuation along the edge of the control element leads to a faster cursor movement and a weaker pressure along the edge of the control element leads to a slower cursor movement. Yamazaki teaches a stronger increasing pressure during the actuation along the edge of the control element leads to a faster cursor movement and a weaker pressure along the edge of the control

element leads to a slower cursor movement (see column 10, lines 4-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the speed of the cursor with the amount of force exerted on the control element as taught by Yamazaki in the method of Miyazaki as modified by Bihusch, in order to provide more accuracy to the user.

14. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch, as applied to claim 25 above, and further in view of Tamagawa (US Patent 6,603,708).

As to **claim 15**, Miyazaki teaches the method of claim 25 but does not teach a display of a character repertoire upon actuation of the edge of the control element, the position of the actuation on the surface of the control element leading to a highlighting of a character at the corresponding position on a display and the most recently highlighted character is input when the control element is released.

Tamagawa teaches a display of a character repertoire (numbers 2-11, see figure 18A) upon actuation of the edge of the control element (10), the position of the actuation on the surface of the control element leading to a highlighting of a character (e.g. 6) at the corresponding position on a display (94) and the most recently highlighted character is input when the control element is released (e.g. 7, see figure 18 B and column 20, lines 15-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the character repertoire of Tamagawa in the

method of Miyazaki as modified by Bihusch, in order to input text to an electronic device with less button presses.

As to **claim 14**, Tamagawa (figure 13A and B) teaches selecting a menu (91) by actuating the edge of the control element (10), the position of the actuation of the control element leading to a highlighting of the menu item at the corresponding position on a display (86) (also see figures 15A and B).

15. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch and Yamazaki, as applied to claim 13 above, and further in view of Tamagawa.

As to **claim 17**, Miyazaki, Bihusch and Yamazaki teach the method of claim 13 but do not teach a highlighting of a character can be selected by changing positions during the actuated state of the control element. Tamagawa teaches a highlighting of a character can be selected by changing positions during the actuated state of the control element (see column 20, lines 15-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the character repertoire of Tamagawa in the method of Miyazaki as modified by Bihusch, in order to input text to an electronic device with less button presses.

16. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch and Yamazaki, as applied to claim 13 above, and further in view of Goren, US Patent 7,190,351.

Regarding **claim 18**, Miyazaki in view of Bihusch and Yamazaki discloses the method according to claim 13, but does not specially teach wherein the character repertoire consists of the letters "A" to "M" at the upper edge of the screen and the letters "N" to "Z" at the lower edge of the screen.

However, Gorgen teaches a character repertoire consists of the letters "A" to "M" at the upper edge of the screen and the letters "N" to "Z" at the lower edge of the screen (Fig. 19 and 20 shows an illustration of the character selection interface with control buttons 200-204 and secondary buttons 300-305 displayed on the screen 110. The control buttons 200-204 may be placed on the left hand side while the secondary buttons 300-305 may be placed on the right hand side for the convenience of a handheld with a jog wheel, col. 17 lines 6-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to have manipulated the character selection interface as taught by Gorgen to arrange the letters "A" to "M" at the upper edge of the screen and the letters "N" to "Z" at the lower edge of the screen to be in conjunction with the control element of Miyazaki as modified by Bihusch and Yamazaki, for the purpose of rapid selection and with ease (col. 17 lines 6-17).

17. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch as applied to claim 25 above, and further in view of Cheng (US Patent 6,809,275).

As to **claim 26**, Miyazaki and Bihush teach the method of claim 25 but do not teach no direct contact exists between the control element (11) and the application casing (15), and the only indirect contact between the control element (11) and the application casing (15) is via the plural springs (17). Cheng (figures 10 or 11) teach no direct contact exists between a control element (210) and an application casing (218), and the only indirect contact between the control element and the application casing is via plural springs (330, 332). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide no direct contact between the control element and the application casing, and the only indirect contact between the control element and the application casing is via the plural springs as taught by Cheng in the method of Miyazaki as modified by Bihusch, in order to provide uniform tactile and displace feedback in response to user push-inputs (see Cheng column 12, lines 15-26).

18. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki in view of Bihusch as applied to claim 25 above, and further in view of Gaultier.

As to **claim 27**, Miyazaki and Bihush teach the method of claim 25 but do not teach the surface of the disc-shaped control element is parallel to its underside across the entire disc-shaped control element. Gaultier teaches a disc-shaped control element (8, figure 6) having a circular upper surface (top surface of 8) and an underside (lower surface of 9) being parallel to one another across the entire disc-shaped control element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a disc-shaped control element having an upper

surface and underside being parallel to one another across the entire disc-shaped control element as taught by Gaultier for the control element of Miyazaki as modified by Bihusch, yielding predictable results of tilting the disc relative to the center axis.

Response to Arguments

19. Applicant's arguments with respect to claims 4-11, 13-15, 17, 18, and 20-28 have been considered but are moot in view of the new ground(s) of rejection. In view of amendments, the references of Gaultier, Cheng, and Sin have been added as new grounds of rejection.

Regarding Miyazaki, a translation has been provided per applicant's request.

Applicant also argues that Miyazaki fails to "register the tilt" and only detects the direction of inclination. The examiner interprets "detecting a direction of inclination" as "registering a tilt" since an inclination is a tilt. Applicant argues that Miyazaki also fails to disclose "controlling a cursor movement" or "continued cursor movement". However the examiner notes Miyazaki teaches controlling a cursor movement and continued cursor movement for example in figure 19. In figure 19 (a) a finger is located at the 12 and an indicator mark or cursor is displayed in the ring under the 12. Then in (B), the finger slides from the 12 position to the 6 position and an indicator mark moves with the finger from the 12 to the 6 which is continued movement. The examiner applies a similar interpretation to figures 4 and 5. The sliding movement is discussed in Miyazaki, for example in paragraphs [0064-0065].

Applicant argues regarding claim 5, that Kishi does not teach the actuation disc is "pivoted and supported over transmission elements". Kishi, as acknowledged by the applicant states the jog dial input device includes a "jog dial 21 rotatably attached to a main body". Since the jog dial is rotatably attached to the main body, the examiner maintains there must exist some piece (i.e. transmission element) attaching the jog dial to the main body. The rotating jog dial is then necessarily pivoted and supported over these attaching pieces, or transmission elements.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLISON WALTHALL whose telephone number is (571)270-3571. The examiner can normally be reached on Mon - Fri 9:30-6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

anw
November 3, 2009

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